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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/820,520	03/28/2001	Masato Yonezawa	07977/270001/US4820	5433
26171	7590	12/10/2004	EXAMINER	
FISH & RICHARDSON P.C. 1425 K STREET, N.W. 11TH FLOOR WASHINGTON, DC 20005-3500			ALEJANDRO MULERO, LUZ L	
			ART UNIT	PAPER NUMBER
			1763	

DATE MAILED: 12/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/820,520

Applicant(s)

YONEZAWA ET AL.

Examiner

Luz L. Alejandro

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 24 November 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-4, 6-14 and 20-34 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6-14, and 20-34 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892).
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11/24/04 has been entered.

### ***Claim Objections***

Claim 1 is objected to because of the following informalities: in line 7, the word "located" is repeated. Appropriate correction is required.

Claim 9 is objected to because of the following informalities: in lines 2-3 the use of the word "downward" in the phrase "a substrate surface downward that is downwardly opposed to the electrode" seems to be repetitive. Correction is requested.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 9 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 9-line 2, the phrase "and said has" is not clear. It seems that the word "said" should be deleted.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-4, 6-14, and 26-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Admitted prior art in view of Izu et al., U.S. Patent 4,410,558.

Admitted prior art shows the invention substantially as claimed including a film formation apparatus comprising: a vacuum chamber; an exhaust means for exhausting the gas from the vacuum chamber to the outside; a first mesh-like showerhead plate electrode 203,204 for supplying an electric energy inside the chamber; a second grounded electrode 202 opposing the first electrode for supplying the electric energy inside the vacuum chamber and wherein the first electrode is located below said second electrode; a supporting means for supporting a substrate 201 opposing the first electrode wherein the substrate is moved in a first direction through the chamber, wherein the substrate is supported between the first and second electrodes, and wherein the substrate is located horizontally and has a substrate surface that is downwardly opposed to the first electrode; an introducing port 206 for introducing gas into the chamber; wherein a plurality of openings are located on a surface of the first electrode opposing the substrate at constant intervals; and a transporting means for transporting a flexible substrate including at least one selected from a winding and an unwinding roll (see applicant's description of the roll to roll method at paragraph bridging pages 1 and 2). For a complete description of the claims, see Fig. 2A and page 3-line 16 to page 4-line 3 of specification). Note that with respect to independent claims 10 and the claims that depend from it, the first and second electrodes described above represent the second and first electrodes of these claims.

Admitted prior art does not expressly disclose the claimed gas supply and exhaust structure, wherein the gas inlet port is located in a position between the substrate and the second electrode, and wherein the gas is exhausted from a plurality

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of openings in the first electrode, the openings being circular. Izu et al. discloses an apparatus comprising a gas inlet port 52 located in a position between a moving substrate 10 and an electrode 58, the electrode 58 comprising a plurality of openings through where the gas is exhausted (see, for example, fig. 3 and its description). In view of this disclosure, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the apparatus of Admitted prior art so as to comprise the gas supply and exhaust structure suggested by Izu et al., because this allows for: a) uniform distribution of the gas across the entire substrate, and b) maintain a uniform flow of the gas. With respect to the shape of the openings for exhausting the gas, it should be noted that the particular shape of the openings is a matter of choice which a person of ordinary skill in the art would have found obvious absent persuasive evidence that the particular configuration of the claimed openings are significant.

Concerning the gas being introduced into said chamber in a direction parallel with said first direction so that a flow of the gas is rectified in a direction away from the film formation surface of the substrate, the admitted prior art in fig. 3 discloses an apparatus in which gas 305 is introduced in a direction that is parallel with a direction of the substrate 301 (see fig. 3 and page 3, lines 3-5 and page 4-line 24 to page 5-line 15 of the specification). In view of this disclosure, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the apparatus of the Admitted prior art modified by Izu et al. so as to introduce the gas in the direction parallel to the first direction as suggested by fig. 3 of the Admitted prior art because this is shown to be conventional. Furthermore, it would have been a matter of a design

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choice to determine the optimum direction of gas flow and would not lend patentability to the instant application absent the showing of unexpected results.

Claims 20-25 and 28-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Admitted prior art in view of Izu et al., U.S. Patent 4,410,558, as applied to claims 1-4, 6-14, 26-27 above, and further in view of Komino et al., U.S. Patent 6,156,151 or Yamazaki, U.S. Patent 4,808,553.

Note that with respect to independent 30 and the claims that depend from it, the first and second electrodes described above represent the second and first electrodes of these claims.

Admitted prior art, and Izu et al. are applied as above but do not expressly disclose that the apparatus further comprises an abnormal discharge preventing plate between the exhaust means and the electrode and having plurality of openings. Komino et al. discloses a plasma apparatus comprising an exhaust means and a plate 118 having a plurality of openings 118a for preventing discharge (see, figs. 1, 4, 7, 9A, 9B, 10 or 11, and their descriptions). Additionally, Yamazaki discloses a plasma apparatus comprising an exhaust means 14 and a plate 20' comprising a plurality of openings which will prevent abnormal discharge from entering the exhaust means. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the apparatus of Admitted prior art modified by Izu et al., as to further comprise a plate as claimed because abnormal discharge can be prevented in the exhaust means.

### ***Double Patenting***

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Applicant is advised that should claim 6 be found allowable, claim 26 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Applicant is advised that should claim 7 be found allowable, claim 27 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).



### ***Response to Arguments***

Applicant's arguments filed 11/24/04 have been fully considered but they are not persuasive. Applicant argues that the combination of references do not disclose or suggest all of the limitations of the independent claims. The examiner respectfully disagrees with such a statement since the combinations of reference render obvious to claimed invention, as detailed in the rejections above.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Luz L. Alejandro whose telephone number is 571-272-1430. The examiner can normally be reached on Monday to Thursday from 7:30 to 6:00.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory L. Mills can be reached on 571-272-1439. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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A handwritten signature in black ink, appearing to read 'Luz L. Alejandro', is positioned above the printed name.

Luz L. Alejandro  
Primary Examiner  
Art Unit 1763

December 4, 2004